

REMARKS

I. PRELIMINARY REMARKS

No claims have been amended. Non-elected claims 11-26 have been canceled. Claims 39-50 have been added. Claims 1-10 and 27-50 remain in the application. Claims 7, 37 and 38 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

II. PRIOR ART REJECTIONS

A. The Rejections

Claims 1-6 and 8-10 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,771,996 to Bowe et al. ("the Bowe patent"). Claims 1-6, 8-10 and 27-36 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Bowe patent and U.S. Patent No. 6,115,626 to Whayne (the "Whayne patent").¹ The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

B. The Cited References

The Bowe patent is directed to ablation and mapping catheter systems that are configured to travel through the patient's vasculature to the heart or other body site. [Column 2, lines 43-47; column 8, lines 38-42; and column 9, lines 2-12.] Referring first to Figure 1, catheter system 10 includes an outer ablation catheter 12 and an inner mapping catheter 14 that slides within the ablation catheter. The outer ablation catheter

¹ In view of the rejection of claims 1-6 and 8-10 under 35 U.S.C. § 102, it appears that the rejection of claims 1-6 and 8-10 under 35 U.S.C. § 103 may be been a typographical error. Clarification is hereby requested.

12 consists primarily of a sheath 34 that carries one or more electrodes 48, while the inner mapping catheter 14 consists primarily of a sheath 32 that carries a plurality of electrodes 50. Turning to Figure 8, another catheter system 80 includes an outer ablation catheter 82, with a tubular wall 84, and an inner mapping catheter 106, with a tubular wall 108, that slides within the ablation catheter. The distal regions 90 and 110 of the ablation catheter 82 and mapping catheter 106 are each formed such that they have a normally circular shape. The distal regions 90 and 110 also respectively carry electrodes 94/96 and 114/116.

The Wayne patent is directed to a system that includes an instrument 12, with an array of mapping electrodes 18, and a pair of separate "roving" instruments 14 and 16. Each "roving" instrument may be used to perform one of the imaging, sensing or therapeutic functions discussed in column 4, lines 9-23.

C. Discussion Concerning the Rejection of Claims 1-6 and 8-10 Under 35 U.S.C. § 102

Independent claim 1 calls for a combination of elements including, *inter alia*, "a relatively short shaft," "a coagulation element ... on the distal region of the relatively short shaft," and a "stimulation element ... on the distal region of the relatively short shaft." The respective combinations defined by claims 2-6 and 8-10 include, *inter alia*, the elements recited in claim 1.

The Bowe patent fails to teach or suggest a variety of aspects of the claimed combinations. For example, the Office Action has taken the position that the sheath 34, as well as the "equivalent counterparts of other embodiments," corresponds to the claimed "relatively short shaft." [Office Action at page 3.] Applicant respectfully submits there is no reasonable interpretation of the phrase "relatively short shaft" that would read on catheters that are configured to be advanced through the vasculature to a pulmonary vein or other target body site.

The "relatively short" issue notwithstanding, the Bowe patent also fails teach or suggest the placement of a coagulation element and a stimulation element on the **same**

shaft.² Even assuming for the sake of argument that one of the Bowe mapping electrodes 50 (or 114 or 116) could be considered a "stimulation element" as was asserted in the Office Action, the coagulation elements and stimulation elements in the Bowe systems are carried on **separate catheters**.

As the Bowe patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1-6 and 8-10 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

D. Discussion Concerning the Rejection of Claims 1-6, 8-10 and 27-36 Under 35 U.S.C. § 103

Independent claims 1 and 27 call for respective combinations of elements including, *inter alia*, "a relatively short shaft," "a coagulation element ... on the distal region of the relatively short shaft," and a "stimulation element ... on the distal region of the relatively short shaft." The combinations defined by claims 2-6 and 8-10 include, *inter alia*, the elements recited in claim 1, and the combinations defined by claims 28-36 include, *inter alia*, the elements recited in claim 27.

The cited references fail to teach or suggest the claimed combinations. As discussed above, the Bowe patent fails to teach or suggest a surgical probe with a "relatively short shaft" and/or a coagulation element and a stimulation element on the same shaft. The Office Action has taken the position that the Whyne patent, which has been cited for its pacing and mapping teachings, remedies the deficiencies in the Bowe patent. Applicant respectfully submits that it fails to do so. The Whyne patent does not, for example, suggest placing a coagulation element and a stimulation element on the same shaft. To the contrary, and much like the Bowe patent, the Whyne patent suggests the use of separate catheters. One of the catheters in the illustrated embodiment carries a mapping device, one the catheters carries an electrode, and one of the catheters carries an

² Note the recitations of "a ... shaft," "the ... shaft" and "the ... shaft" in independent claim 1.

imaging device. [Column 4, lines 4-23; column 6, line 64 to column 7, line 13; and column 7, lines 49-63.]

Accordingly, and assuming for the sake of argument that there was some reason to combine their teachings, the Bowe and Whayne patents fail to establish a *prima facie* case of obviousness with respect to the inventions defined by independent claims 1 and 27. The rejection of claims 1-6, 8-10 and 27-36 under 35 U.S.C. § 103 should, therefore, be withdrawn.

IV. NEWLY PRESENTED CLAIMS 39-50

Newly presented claims 39-42 depend from independent claim 1 and, therefore, are patentable for at least the same reasons as claim 1.

Newly presented claims 43-46 depend from independent claim 27 and, therefore, are patentable for at least the same reasons as claim 27.

Newly presented independent claim 47 calls for a combination of elements comprising "a relatively short shaft defining a distal region and a proximal region," "means for coagulating tissue on the distal region of the relatively short shaft" and "means, having a different configuration than the means for coagulating tissue, for stimulating tissue on the distal region of the relatively short shaft." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 47-50 are patentable thereover.

V. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned

representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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Date

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